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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/663,688 | 09/17/2003 | Koichi Nagoshi | P23994 | 3984 |
| 7055 7590 04/29/2009 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191 | | | | |
| EXAMINER MUHEBBULLAH, SAJEDA | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 2174 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 04/29/2009 | | ELECTRONIC | | |

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/663,688
Filing Date: September 17, 2003
Appellant(s): NAGOSHI ET AL.

William Pieprz, Attorney
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 09, 2009 appealing from the Office action mailed April 8, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|--------------|---------------|---------|
| 2004/0024811 | KITADA ET AL. | 02-2004 |
| 6,885,469 | TANIMOTO | 04-2005 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 28-29, 36-48 and 55-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitada et al. ("Kitada", US 2004/0024811) in view of Tanimoto (US 6,885,469).

As per claim 28, Kitada teaches a multifunction apparatus having at least a scanning function and not having a facsimile transmission function (para.0023, lines 15-16, *MFD may not have fax capability*), the multifunction apparatus connected with a server via a network, the server storing information regarding a menu (para.0051, lines 12-27; para.0057), the menu being displayable on the multifunction apparatus, the multifunction apparatus comprising:

a scanner configured to scan a document (para.0022, lines 4-7);

a panel configured to display a menu representing functions of the multifunction apparatus (Figs.3-6); and

a controller configured to communicate with the server to receive the information regarding the menu from the server, and to display a menu on the panel based on the information regarding the menu received from the server (para.0051, lines 12-27),

the controller being configured to send, to the server, based on the information regarding the menu, scanned image data together with predetermined information indicating another apparatus having a facsimile transmission function and being capable of transmitting the image data to a recipient by facsimile transmission (para.0026, 0028, lines 14-15, *RightFax converts image data then sends via facsimile services to recipient*), when a predetermined menu indicating a facsimile transmission function is displayed on the panel (para.0026; para.0047-0048), of the

multifunction apparatus, the information regarding the menu including the predetermined menu indicating the facsimile transmission function, and when a facsimile transmission is selected on the menu (Fig.5; para.0047-0048; para.0026),

whereby the server transmits, to the another apparatus, the image data scanned by the multifunction apparatus, based on the predetermined information, the server being distinct from the multifunction apparatus and from the another apparatus (para.0026; Fig.1).

However, Kitada does not teach the another apparatus to be a multifunction apparatus. Tanimoto teaches a multifunction apparatus which transmits data from a multifunction fax server to a receiving apparatus (Tanimoto, Fig.1, fax server 1; col.5, lines 57-60). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Tanimoto's teaching with Kitada's apparatus in order to route data to alternate destinations and perform other functions.

As per claim 29, the apparatus of Kitada and Tanimoto teaches the multifunction apparatus, wherein the controller utilizes a scanning function to scan a document, when the facsimile transmission is selected on the menu (Kitada, para.0026; para.0047-0048).

As per claim 36, the apparatus of Kitada and Tanimoto teaches the multifunction apparatus wherein the information regarding the menu is utilized for the multifunction apparatus and also for another multifunction apparatus (Kitada, para.0027; Fig.1, MFDs 10-30; para.0033).

As per claim 37, the apparatus of Kitada and Tanimoto teaches the multifunction apparatus, wherein the information regarding the menu is utilized only for the multifunction apparatus (Kitada, para.0022, lines 7-8).

As per claim 38, the apparatus of Kitada and Tanimoto teaches the multifunction apparatus, wherein the information regarding the menu is utilized for at least one of a plurality of functions of the multifunction apparatus (Kitada, para.0027).

As per claim 39, the apparatus of Kitada and Tanimoto teaches the multifunction apparatus, wherein at least one of a plurality of functions of the multifunction apparatus is an operation customized for a particular user (Kitada, para.0033; para.0039).

As per claim 40, the apparatus of Kitada and Tanimoto teaches the multifunction apparatus, wherein the information regarding the menu contains a menu item name, the menu item name indicating a job that the multifunction apparatus performs (Kitada, Fig.4; para.0044).

As per claim 41, the apparatus of Kitada and Tanimoto teaches the multifunction apparatus, wherein the information regarding the menu contains a menu item name, a job-ID and a job parameter (Kitada, para.0039; para.0043, lines 19-21; para.0044).

As per claim 42, the apparatus of Kitada and Tanimoto teaches the multifunction apparatus, wherein the multifunction apparatus additionally has at least one of a scanning, printing, and a facsimile transmission function and the job ID includes at least one of copying, printing, scanning and fax transmission (Kitada, para.0039; para.0043, lines 19-21; para.0044).

As per claim 43, the apparatus of Kitada and Tanimoto teaches the multifunction apparatus, wherein the job parameter includes at least one of an image type and paper size for copying (Kitada, para.0023; para.0039, lines 10-11).

As per claim 44, the apparatus of Kitada and Tanimoto teaches the multifunction apparatus, wherein the job parameter includes at least one of an image type, paper size and resolution for printing (Kitada, para.0023; para.0039, lines 10-11).

As per claim 45, the apparatus of Kitada and Tanimoto teaches the multifunction apparatus, wherein the job parameter includes at least one of an image type, paper size, resolution and file format for scanning (Kitada, para.0039, lines 10-11).

As per claim 46, the apparatus of Kitada and Tanimoto teaches the multifunction apparatus, wherein the job parameter includes at least one of an image type, paper size, resolution and file format for facsimile transmission (Kitada, para.0023; para.0039, lines 10-11).

As per claim 47, the apparatus of Kitada and Tanimoto teaches the server, wherein the information regarding the menu contains information regarding a maximum number of characters that can be displayed on the display of the multifunction apparatus (Kitada, para.0033, lines 5-9).

As per claim 48, the apparatus of Kitada and Tanimoto teaches the server, wherein the information regarding the menu contains information regarding capabilities of the multifunction apparatus (Kitada, para.0033, lines 5-9).

Claim 55 is similar in scope to claim 28, and is therefore rejected under similar rationale.

Claims 56-59 are similar in scope to claims 36-39 respectively, and are therefore rejected under similar rationale.

As per claim 60, the apparatus of Kitada and Tanimoto teaches the multifunction apparatus according to claim 28, wherein the another multifunction apparatus transmits, to the multifunction apparatus, a job execution result, when the another multifunction apparatus completes the facsimile transmission (Tanimoto, col.4, lines 48-61).

As per claim 61, the apparatus of Kitada and Tanimoto teaches the multifunction apparatus according to claim 28, wherein when the controller sends, to the server, the scanned

image data, the controller sends to the server, a job parameter, and the server transmits to the another multifunction apparatus, the image data scanned by the multifunction apparatus with the job parameter (Kitada, para.0027, lines 7-10, para.0044).

Claim 62 is similar in scope to claim 46, and is therefore rejected under similar rationale.

As per claim 63, the apparatus of Kitada and Tanimoto teaches the multifunction apparatus according to claim 61, wherein the another multifunction apparatus transmits, to the receiving apparatus, the image data scanned by the multifunction apparatus, based on the job parameter (Kitada, para.0044).

(10) Response to Argument

Applicant argued the following:

a) None of the cited references address the problem of how a multifunction apparatus that does not have a facsimile transmission capability can transmit data to a recipient that has a facsimile reception capability.

b) Kitada does not disclose sending to the server scanned image data with predetermined information indicating another facsimile apparatus having a facsimile transmission function.

c) Tanimoto does not teach transmitting the image data to the receiving apparatus by facsimile transmission.

d) Kitada does not disclose scanning a document when the facsimile transmission is selected on the menu.

e) Kitada does not disclose information regarding a menu.

f) Kitada does not disclose a job ID.

g) Kitada is limited to scanning job parameters and contains no disclosure to features of copying, printing, or facsimile functions.

h) None of the profile items of information in Kitada relate to a maximum number of characters that can be displayed on the display of the multifunction apparatus.

i) None of the profile items of information in Kitada relate to the capabilities of the multifunction apparatus.

j) Tanimoto contains no disclosure regarding transmitting a job execution result upon completion of facsimile transmission.

k) Kitada deals with scanning parameters and not with image data and a job parameter being transmitted by the server to the another multifunction apparatus.

l) No relationship to a transmission by the another multifunction apparatus to the receiving apparatus of the image data scanned by the multifunction apparatus based on the job parameter.

The Examiner disagrees for the following reasons:

Per a), Kitada teaches an example of one multifunction apparatus which does not include a fax (para.0023, lines 15-16) but has to ability to route documents to a fax server which has the ability to fax data to recipients (para.0026, lines 6-8, para.0028, lines 14-15).

Per b), Kitada teaches sending the image data along with information indicating another apparatus capable of faxing the data to the recipient (para.0034, lines 16-18; para.0028, lines 14-15; para.0033, lines 5-12, *when the scan server receives an image indicated to be faxed, the scan*

server routes the image to the appropriate fax server which is set in the parameters of the profile)

Per c), In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Tanimoto teaches a fax server which is a multifunction apparatus. Kitada teaches the fax server which is able to fax documents to the recipient.

Per d), Kitada teaches the ability to fax a document wherein the fax function is initialized and then the document to be faxed is inputted (para.0047, lines 5-7). Per e), Kitada teaches information regarding a menu (para.0027, 0033; *the capabilities of the MFD is set according to the profile*).

Per f), Kitada teaches the tracking of jobs (para.0043, lines 9-21).

Per g), Kitada teaches the MFD to include parameters for operating its functions such as scanning, copying, printing, and faxing (para.0039, lines 5-8; para.0044, lines 3-6; *default parameters*)

Per h), Kitada teaches the profile to include parameters relating to the data format used (para.0033, lines 9-11).

Per i), Kitada teaches the profile to include parameters relating to various capabilities of the MFD (para.0033).

Per j), Tanimoto teaches the display of a job execution result (col.4, lines 48-61, *result is displayed when an error is detected*).

Per k), Kitada teaches the transmission of the image data being sent along with parameters (para.0027, lines 7-10)

Per l), Kitada teaches the image data to be scanned and sent to the another apparatus based on parameters set (para.0044).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Sajeda Muhebbullah
Patent Examiner
4/26/2009

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